

REMARKS

Claims 1, 2, 5, 6, 9, 10, 13, 14 and 17-19 are pending in this application. By this Amendment, the specification is amended to correct typographical errors appearing therein, claims 1 and 17 are amended to address the form and art rejections as discussed below, claims 9, 10, 13 and 14 are amended to address the form rejections as discussed below, claims 3, 4, 7, 8, 11, 12, 15 and 16 are canceled, and claims 2, 5, 6, 18 and 19 are amended for consistency.

No new matter is added by this Amendment. Support for reciting the silica powder to be substantially spherical or perfectly spherical may be found in the original specification at, for example, the paragraph bridging pages 12 and 13 of the specification and Figure 2. Support for reciting the average grain diameter of the silica powder may be found in, for example, original claim 3.

I. Rejection Under 35 U.S.C. §112, Second Paragraph

Claims 1-19 were rejected under 35 U.S.C. §112, second paragraph. This rejection is respectfully traversed.

First, the Patent Office alleged that the term "globular" was indefinite. Applicant respectfully disagrees. It is clear from the specification that "globular" is used to refer to a silica powder that is substantially spherical to perfectly spherical. See, for example, the paragraph bridging pages 12 and 13 of the specification, as well as Figure 2 showing this shape of the silica powder. In an effort to expedite examination, claims 1 and 17 have each been amended to replace "globular" with the definition that the powder is substantially spherical or perfectly spherical.

Second, the Patent Office alleged that claims 9-16 and 18 were unclear in reciting a method. By this Amendment, claims 9, 10, 13 and 14 have each been amended to more clearly recite the method steps involved. Further, the allegation that the claims are indefinite

in not further limiting the claims from which each depends is incorrect. Each of claims 9, 10, 13, 14 and 18 specifies a specific method that the powder is used in, the claims from which these claims depend not being so limited. Thus, claims 9, 10, 13, 14 and 18 restrict the scope with which the polishing agent may be used, and thus clearly limit the polishing agent claims such that the dependency is proper.

For the foregoing reasons, reconsideration and withdrawal of this rejection are respectfully requested.

II. Rejection Under 35 U.S.C. §102(b)

Claims 1, 2, 5-10, 13-16 and 18 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,261,476 (Kwok). This rejection is respectfully traversed.

First, Applicant notes that claim 3 was not rejected relying upon Kwok. Accordingly, claims 1 and 17 have each been amended to incorporate the subject matter of original claim 3 therein. For this reason alone, the rejection is now believed to be moot.

Further, it was alleged in the Office Action that to substitute substantially spherical or perfectly spherical silica powder for the silica described in Kwok would have been a mere design expedient. Applicant disagrees. As explained at page 18, lines 15-25 of the specification, because the silica is substantially spherical or perfectly spherical, the polishing rate can be increased compared to that of a conventional polishing agent, and a workpiece can be made flat without damaging it and without degrading the surface roughness thereof even though the polishing rate is same or higher compared to a conventional lapping process. Such clearly indicates that the substantially spherical or perfectly spherical silica powder of the present invention is not functionally equivalent to other silicas, and therefore it would not have been obvious for one of ordinary skill in the art, based upon the teachings of Kwok, to have selected such a silica powder for use as a polishing agent.

For the foregoing reasons, reconsideration and withdrawal of this rejection are respectfully requested.

III. Rejection Under 35 U.S.C. §103(a)

Claims 17 and 19 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,196,901 (Minami) in view of Kwok. This rejection is respectfully traversed.

In the Office Action, it was alleged that Minami described the process steps of claims 17 and 19 except for the required polishing agent used in the process. The Patent Office then alleged that Kwok suggested such polishing agent, and thus alleged that the use of such polishing agent in the Minami process would have been obvious. Applicant again respectfully disagrees.

In particular, for all the same reasons discussed extensively above, Kwok fails to teach or suggest the polishing agent as required in claims 17 and 19. Thus, even if the references were to have been combined in the manner alleged by the Patent Office, the process of claims 17 and 19 would not have been achieved.

For the foregoing reasons, reconsideration and withdrawal of this rejection are respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 2, 5, 6, 9, 10, 13, 14 and 17-19 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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